

REMARKS

Rejection Based on 35 U.S.C. §103(a) Over Jones et al. or Skonecki in View of Roulleau

In the Office Action mailed from the United States Patent and Trademark Office on January 26, 2006, the Examiner rejected claims 12-15, 26-27, 35 and 37-41 under 35 U.S.C. § 103(a) as unpatentable over Jones et al. (Patent No. 6,172,328) or Skonecki (Patent No. 5,305,550) in view of Roulleau (Patent No. 5,142,976). Applicants respectfully traverse this rejection and submit that based upon the amendments made to the claims and the distinctions pointed out below, none of the cited § 103(a) references render the claimed invention obvious.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, **there must be a reasonable expectation of success**. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

As an overview, Applicant submits that the new amendments emphasize limitations not taught or made obvious by the references cited above, or their combination. Specifically, the petal of Applicants' claimed invention remains etch-free and free from cuts at the site on the petal where the image exists. Moreover, Applicant reiterates that the image-laying process is etch-free and cut-free, and capable of being produced in mass. That is, the

etch-free, cut-free image can be produced over and over again on many petals of many flowers. Finally, Applicant submits its claimed invention is limited to petals of flowers with soft surfaces and not to more rigid surfaces such as the outer shell of an egg. Thus, Applicant respectfully traverses the Examiners rejections.

As newly amended, Jones does not teach or suggest all claim limitations of Applicants' claimed invention

As part of the basis for his rejection, the Examiner stated,

“Jones flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. Therefore, it is the position of the Examiner that the flower is in an undamaged form.” (emphasis added)

Applicants' respectfully point out that in light of the new amendments and for the following reasons, the foregoing is irrelevant. First, at the precise locus on the petal where the image is, the markings and ink left by the image in Applicants' invention is so different than the area beneath the markings of the prior art that one of ordinary skill in the art would not think the claimed invention is obvious in light of the references presented by the Examiner. Put another way, the image markings on Applicants' petal are etch-free, cut-free. Yet the image markings of Jones are not.

In fact, Applicants readily acknowledge the flower, petals or leaves described in Jones are capable of photosynthesizing and respiring even after the design image is placed on the flowers' surfaces. And, Applicants also agree that Jones' flower is undamaged after the image is provided. However, on the petal, and at the exact location where the image is placed, the markings left on the petal are unobviously different in Jones than in Applicants' claimed invention.

To illustrate the above point, Jones' method and apparatus for applying the image to the flower requires permanent disruption (i.e., penetration, etching, or cutting) or a similar compromise to the cellular surface of the petal when applying the image to the flower. (See Jones, Column 1, line 14, line 56, lines 64-65). Jones' specification is clear on this point. It says Jones teaches a method employing laser energy through use of mirrors, lenses and optics to *etch*, *burn*, or *cut* through the surface of a product. (Id.)(emphasis added). This is patently different than Applicants' currently amended claim limitations that teach of the area on the petals on which the image is located as being "free from etched and cut" images. Put another way, as amended, Applicant's claims provide for an image, which without causing permanent disfigurement, penetration or cut to the cellular surface of the petal at the exact site of the image, is placed on a petal. In contrast to Jones' image, the image in Applicants' claimed invention is transferred, provided, and placed onto the petal, and not, etched, cut or permanently penetrated at the site where the image exists. In sum, though the flower in Jones as a whole is undamaged and capable of photosynthesis and respiration, at the exact point where the image is applied and found on the flower, there is a compromise in the cellular surface of the flower by being etched or cut, which is unlike the petal of the claimed invention that is "free from etched or cut" images.

Hence, Jones neither teaches nor suggests the claim limitations of Applicants' currently amended invention.

No reasonable expectation of success would be anticipated when combining Jones with Roulleau

Combining Jones with Roulleau prevents Roulleau from working for its intended purposes. Moreover, a reasonable expectation of success would not be anticipated using

the foregoing combination of references. First, Roulleau teaches of poultry eggs, while Jones teaches specifically of etching, cutting or burning into the surface of the product. (See Abstract line 1; Col. 1, lines 12-15, Col. 3, lines 21-29; Col. 4, lines 21-25). As such, Roulleau's intended function of providing decorative motifs on *uncooked* poultry eggs (See Col. 1, lines 4-5) using the cutting, burning and etching method and apparatus disclosed in Jones would be unsuccessful and unworkable for Roulleau's intended purpose. The inner soft portion of the egg would leak out through the areas left exposed by the etching, burning and cutting process. Accordingly, the claim set as amended is not made obvious by the cited references because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine art that teaches or in the knowledge generally available to one of ordinary skill in the art, to combine art that teaches of poultry eggs with the art of flowers. Applicant again respectfully submits that a *prima facie* case of obviousness has not been met and thus, the cited references do not make obvious the claims as provided herein.

Skonecki also does not teach or suggest all claim limitations in Applicants' newly amended claims, and no reasonable expectation of success would be anticipated as a result of combining Skonecki with Roulleau

First, Applicants currently amended claimed invention is not made obvious by the Skonecki reference cited by the Examiner, because Skonecki teaches away from the claimed invention. Specifically, Skonecki discloses a hand-held applicator used to create an individualized image on a flower. This hand-held applicator precludes the ability to mass produce that particular image. (See Col. 1, lines 27-35; Col. 1, lines 53-55; Col. 1, lines 62-64; Col 2, lines 1-15; Col. 2, lines 41-44). In contrast, Applicants' independent

claims 35 and 37 recite a “repeatable, identical, pad-printed, image provided on each of the flowers in the group of flowers.” Thus, the independent claims are not made obvious by the cited references because Skonecki teaches away from the claims.

Additionally, the claim set as amended is not made obvious by the cited references because Jones teaches away from Skonecki. Again, Jones teaches of etching or cutting at the locus where the image is provided on the leaf or petal. (See Abstract line 1; Col. 1, lines 12-15; Col. 3, lines 21-29; Col 4, lines 21-25.) In contrast, Skonecki teaches of the image being provided on the surface by a “hand-held” and individual applicator, “such as a pen.” Pens do not etch or cut in order to make an image appear on a surface. Rather, ink or a similar medium is laid or transferred onto the surface. Thus, Skonecki teaches away from Jones and also neither teaches nor suggests the claim limitations of Applicants’ currently amended claim set.

Finally, the Examiner states,

“It is noted that Applicant’s claimed invention is drawn to a product by process namely pad-printing an image onto a flower. However, since Roulleau teaches pad-printing an image onto a delicate organic product, such as an egg, one of ordinary skill motivated by the desire to place an image onto a flower would find it obvious to use the pad-printing process as disclosed by Roulleau to provide an image onto the flower as both the egg and flower are delicate organic products.”

First, Roulleau does not teach pad printing on an image as broad as a “delicate organic product.” Roulleau specifically teaches printing on “uncooked poultry eggs.” (Col. 3, 17-33). The claims and specification are clear on this point. (Id.) And, Roulleau teaches of printing in a way different than disclosed in Applicants’ specification; on the egg by a machine comprising two angled facets. Applicants teach of printing on a petal that leaves a surface-only image on the petal. Second, “in spite of the fact that the claim

may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established.” *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The Federal Circuit held that only when the prior art discloses a product, which reasonably appears to be either identical with or only slightly different than a product claimed in a product -by-process claim is a section 103 rejection fair and acceptable. (Id.) The product described in Applicants’ claimed invention as amended is neither identical nor only slightly different than the products disclosed in the prior art references. Jones’ discloses surfaces on flowers that have been etched, cut or penetrated; Roulleau discloses *eggs* with images on them. Applicants’ claimed invention provides images on *petals* of flowers that are free from *etching or cuts*. Thus, the claimed invention is further rendered unobvious in light of the references.

Thus, for at least the foregoing reasons, Applicant respectfully submits that the references cited herein do not render obvious the independent claims. In addition, dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited references do not make obvious the newly amended claim set provided herein.

CONCLUSION

Applicant submits the amendments made herein do not add new matter and the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, or if the Examiner would like to suggest amended claim language, the Examiner is invited to call the undersigned.

DATED this 25 day of April, 2006.

Respectfully submitted,

Michael R. Krieger
Attorney for Applicant
Registration No. 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893

ARO/lc